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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,525	03/06/2002	Georges Metzger	PW/3-22076/A/PCT	7209

324 7590 08/13/2003

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,525

Applicant(s)

METZGER ET AL.

Examiner

Venkataraman Balasubramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10-25 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) 31-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10, 17, 19, 24 and 25 is/are rejected.
- 7) ☒ Claim(s) 11-16, 18, 20-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' response filed on 5/27/2003, is made of record.

Claims 1-6, 10-25 and 31-36 are pending. Of which claims 31-36 had been withdrawn from consideration as noted in the previous office action.

Claims 1-6, 10-25 are under examination.

In view of applicants' response, 112 second paragraph rejection over claim 2 is deemed as obviated. However, the following rejections apply

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 10, 17, 19, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cowman et al. WO 96/00221 for reasons of record. To repeat:

Cowman et al. teaches several bis triazinyl stilbene sulfonic acid for use as optical brightening agents, which include compounds claimed herein. See formula I on page I and note all the variable groups R, R₁, R₅ and M definition include those recited in the instant R₁, R₂, R₃ and M groups. See page 3-5 for compounds of interest and see page 8 for the process of making them.

While said compounds do not anticipate the scope of claim 10, they are very closely related having a methyl group on the nitrogen of the anilino group in the instant claims vs hydrogen on the nitrogen in the reference. t. However, compounds that differ only in having H vs Me are not deemed patentably distinct absent evidence of superior or unexpected properties. See for compounds that differ only as H vs Me on nitrogen, see Ex parte Weston 121 USPQ 428; In re Doebel 174 USPQ 156. Thus it would have been obvious to one skilled in the art at the time of the invention was made to expect instant compounds to possess the utility taught by the applied art in view of the close structural similarity outlined above.

Claims 1-6, 10, 17, 19, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rohringer et al. WO 98/42685 for reasons of record. To repeat:

Rohringer et al. et al. teaches several bis triazinyl stilbene sulfonic acid for use as optical brightening agents, which include compounds claimed herein. See formula I on page 2 and note all the variable groups X, R₁, R₂ and M definition include those recited in the instant R₁, R₂, R₃ and M groups. Note especially amino acid is also included as a

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R₁ substituent which corresponds to instant R₁. See page 3, 4, 5 for various preferred embodiments. See examples 1-17 on pages 14-27.

While said compounds do not anticipate the scope of claim 10, they are very closely related having a methyl group on the nitrogen of the anilino group in the instant claims vs hydrogen on the nitrogen in the reference. t. However, compounds that differ only in having H vs Me are not deemed patentably distinct absent evidence of superior or unexpected properties. See for compounds that differ only as H vs Me on nitrogen, see Ex parte Weston 121 USPQ 428; In re Doebel 174 USPQ 156. Thus it would have been obvious to one skilled in the art at the time of the invention was made to expect instant compounds to possess the utility taught by the applied art in view of the close structural similarity outlined above.

Applicants' traversal that examiner had made a homologue rejection is not correct. The rejection is not a homologue rejection. It is based on hydrogen vs methyl on nitrogen. As clearly stated by the applicants, it is an issue of tertiary amine vs secondary amine. The cited case law provides support for such rejections. Applicants seem to have not considered the case law cited and have limited their argument to homologue issue and the traversal is therefore not persuasive.

The rejection is proper and is maintained.

Allowable Subject Matter

Claims 11-16, 18, 20-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Said claims would be allowed

since specific species embraced in these claims are not taught or suggested by the art of record or from a search in the relevant art area.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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V. Balasubramanian (Bala)

8/7/2003

Mukund J. Shah

MUKUND J. SHAH

SUPERVISORY PATENT EXAMINER

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